



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,921	08/07/2003	Samuel Henderson	003797.00553	8857

28319 7590 01/24/2007
BANNER & WITCOFF LTD.,
ATTORNEYS FOR CLIENT NOS. 003797 & 013797
1001 G STREET, N.W.
SUITE 1100
WASHINGTON, DC 20001-4597

EXAMINER	
TRAN, QUOC DUC	

ART UNIT	PAPER NUMBER
2614	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/635,921

Applicant(s)

HENDERSON, SAMUEL

Examiner

Quoc D. Tran

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 4-5, 7-9, 15-19, 21-22, 24-26 and 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emerson, III (US 2003/0043974) in view of Lautenschlager et al (6,970,543).

Consider claims 1, 4, 18, 21, 36. Emerson teaches a method of obtaining and resolving caller ID in a communication system, comprising selecting, by a first user, a caller ID associated with an identity of the first user (page(s). 5, § 0039 through 0040); transmitting, upon selection, the caller ID to at least one contact from a list of contacts selected from the first user's contact database (page(s). 5, § 0039 through 0040); and associating the first user's selected caller ID in a second user's communication database with the first user (page(s). 6, § 0043-0044).

Emerson does not suggest of transmitting, upon selection of the caller identification and before initiating communication with a second user (i.e., "deliver selected identification information from one user to another before communication has been established"). However, Lautenschlager teaches a method and device for call identification that enable the user to select the identification data and transmitting to the destination user before communication has been

Art Unit: 2614

established (i.e., in or upon call setup) between the users (abstract; col. 1 line 54 – col. 2 lines 8; col. 2 lines 23-52).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to incorporate the teaching of Lautenschlager into view of Emerson in order for providing called party with adequate information prior to take the call.

Consider claims 2, 19. Page(s) 7, § 0050, page(s) 8, § 0065 of Emerson reads on the limitation browsing a plurality of predefined identifiers stored in the first user's database.

Consider claims 4, 21. Page(s) 5, § 0039 of Emerson reads on the limitation creating the first user's own identifier.

Consider claims 5, 22. Page(s) 6, § 0043-0044 of Emerson read on the limitation storing the selected caller ID in a storage relating to the first user.

Consider claims 7-9, 24-26. Page(s) 6, § 0043 of Emerson reads on the limitations detecting an event (i.e., receiving caller ID from a user), detecting the type of the identifier (i.e., electronic business card) and storing the EBC.

Consider claims 15-17, and 32-34. Page(s) 5, § 0039 of Emerson reads on the first user's ID may be an image, a video or an animation.

Consider claim 35. Emerson teaches a method of obtaining and resolving caller ID in a communication system, comprising selecting, by a first user, a caller ID associated with an identity of the first user (page(s). 5, § 0039 through 0040); transmitting, upon selection, the caller ID to at least one contact from a list of contacts selected from the first user's contact database (page(s). 5, § 0039 through 0040); and associating the first user's selected caller ID in a second user's communication database with the first user (page(s). 6, § 0043-0044).

Emerson does not suggest a mobile terminal and transmitting, upon selection of the caller identification and before initiating communication with a second user (i.e., “deliver selected identification information from one user to another before communication has been established”). However, Lautenschlager teaches a method and device for call identification that enable the user to select the identification data and transmitting to the destination user before communication has been established (i.e., in or upon call setup) between the users (abstract; col. 1 line 54 – col. 2 lines 8; col. 2 lines 23-52; col. 4 lines 29-33).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to incorporate the teaching of Lautenschlager into view of Emerson in order for providing called party with adequate information prior to take the call.

3. Claims 3 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emerson, III (US 2003/0043974) in view of Lautenschlager et al (6,970,543) and further in view of Awada et al (6,873,861)

Consider claims 3, 20. Emerson does not teach browsing and downloading identifiers from a remote storage facility or network.

Awada teaches browsing and downloading identifiers from a remote storage facility or network (column(s) 4, line(s) 48 through column(s) 5, line(s) 7) for the purpose of storing and providing electronic business cards to another cellular telephone user (column(s) 1, line(s) 5-12).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Awada into the teachings of Emerson for the purpose mentioned above.

4. Claims 6 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emerson, III (US 2003/0043974) in view of Lautenschlager et al (6,970,543) and further in view of Morkel (US 2002/0052921).

Consider claims 6, 23. Emerson does not teach transmitting the caller ID to the list of contacts.

Morkel teaches transmitting the caller ID to the list of contacts (page(s) 1, ¶ 0007; page(s) 2, ¶ 0011; page(s) 3, ¶ 0035) for the purpose of securely acquiring, handling and maintaining contact information (page(s) 1, ¶ 0002, 0006).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Morkel into the teachings of Emerson for the purpose mentioned above.

5. Claims 10 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emerson, III (US 2003/0043974) in view of Lautenschlager et al (6,970,543) and further in view of Beaton et al (6,442,263).

Consider claims 10, 27. Emerson does not teach overriding, upon the second user selecting an option, the first user's self-chosen ID information for the second user's choice of ID information for the first user.

Beaton teaches overriding, upon the second user selecting an option, the first user's self-chosen ID information for the second user's choice of ID information for the first user (i.e., the user can EDIT the bizcard with new information; column(s) 7, line(s) 52-65) for the purpose of manipulating the CLID information to provide enhanced user interface (column(s) 3, line(s) 4-5).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Beaton into the teachings of Emerson for the purpose mentioned above.

6. Claims 11-14 and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emerson, III (US 2003/0043974) in view of Lautenschlager et al (6,970,543) and further in view of Toyryla et al (US 2003/0083086).

Consider claims 11-14, and 28-31. Emerson does not teach that the ID is music, speech or ring tone.

Toyryla teaches distributing electronic business cards, ringing tones and logos (page(s) 3, ¶ 0042) for the purpose of managing group creation and membership definition between users using standard user-to-user communication facilities (page(s) 3, ¶ 0042).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Toyryla into the teachings of Emerson for the purpose mentioned above.

Response to Arguments

7. Applicant's arguments filed 10/26/2006 have been fully considered but they are not persuasive.

Regarding applicant argument that Lautenschlager is improperly applied to the rejected claims and that the claimed feature “upon selection of the caller identification and **before initiating communication** with a second user”, mainly, the limitation **before initiating communication with a second user is distinctly different than established communication.**

Art Unit: 2614

Accordingly, the examiner respectfully disagrees with applicant arguments. This limitation was directly obtained from applicant previous amendment filed 5/17/2006.

The passage recited, "*The Specification provides support for these amendments. (See, e.g., Paragraph 1, lines 2-3 stating "[A]spects of the invention relate to a method that can be used to deliver selected identification information from one user to another user before communication has been established."*)

This clearly suggested that the amended limitation (i.e., before initiating communication with a second user) is equivalent to before the established communication between the users. Thus, the claimed limitation is properly applied by Lautenschlager reference in which the caller identification is transmitted to the destination party within the call setup message. It should be noted that the phrase "within the call setup message" (see col. 1 lines 55-56) signify that the caller information is traveling to the destination device before any communication or established communication between the caller and the destination party. Therefore, Lautenschlager reference teaches the limitation as provided in record.

Regarding applicant arguments that Emerson failed to disclosed or teach of "transmitting the caller identification to at least one contact from a list of contact selected from the first user contact database". Accordingly, the examiner respectfully disagrees with applicant arguments. Firstly, paragraph 34 lines 1-3 of Emerson disclosed of a stored profile data that arranged to be transmitted to the other party. Thus, the stored profile data must be stored in some kind of database for the first user. Therefore, Emerson meets the claimed feature of "the first user database". Secondly, paragraph 39 suggested that the user could arrange to have the profile information combined into a message for delivered to the other party. The "information

Art Unit: 2614

includes...phone number and other **contacts numbers...**". Thus, user can select contact from the list to be transmitted to the destination party. Therefore, Emerson clearly reads on the limitation as claimed.

Applicant continues to present similar arguments with respect to the dependent claims. Therefore, examiner responses will be the same as those addressed above.

Conclusion

8. Any response to this action should be mailed to:

Mail Stop ____ (explanation, e.g., Amendment or After-final, etc.)
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Facsimile responses should be faxed to:
(571) 273-8300

Hand-delivered responses should be brought to:
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Quoc Tran** whose telephone number is **(571) 272-7511**. The examiner can normally be reached on M, T, TH and Friday from 8:00 to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Curtis Kuntz**, can be reached on **(571) 272-7499**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Technology Center 2600** whose telephone number is **(571) 272-2600**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

QUOC TRAN
PRIMARY EXAMINER

AU 2614

January 15, 2007